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In the Supreme Court of the United States

OCTOBER TERM, 1941.

No. 1141.

OTTO C. BERRY and GENERAL MOTORS CORPORATION,
Petitioners,

v.

BOHN ALUMINUM & BRASS CORPORATION and
ADOLPH L. NELSON.

RESPONDENTS' REPLY TO PETITION FOR CERTIORARI.

ARTHUR C. DENISON,
GEORGE F. SCULL,
FRANK J. KENT,
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THE GATES LEGAL PUBLISHING CO., CLEVELAND, OHIO

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I.

The statement of facts in the petition is inaccurate in many particulars, and misleading by reason of omissions; but, when all is said and done, this case remains an ordinary patent case, disclosing the common situation in which an early inventor, with a commercially worthless device but with some broad words in his claims, undertakes to blanket the later art, as developed by others into practical form. Against a background where it is conceded[1] that there was only a substitution of known materials with their known respective qualities, the court below has found that there was no new method of operation nor any new result (R. 2890, 2891). This court does not often review such a question.

[1] By plaintiff's expert, as recited in the opinion below (R. 2888, 2890).

II.

Much of the petition and brief refers to the claim that the respondents (defendants below) had made patent pooling contracts with one or both of two strangers to the record,[2] which contracts, it is insinuated, were unlawful. If this argument means anything, it means that *because* a defendant, holding patents upon his infringing devices, has misused these patents, *therefore* the plaintiffs' otherwise invalid patent should be sustained. We believe this court will not wish to spend its time in consideration of such a glaring *non sequitur*; and we feel justified in ignoring this subject matter.[3]

III.

Petitioner would have us understand that the patentability of Berry over the prior art had been repeatedly sustained by numerous tribunals, as enumerated and recited on page 6 of the petition. In fact this patentability never was sustained by any "tribunal," except by the so-called "Law Examiner."[4] Neither the Examiner of Interferences, nor the Board of Appeals, nor the Court of Customs and Patent Appeals, nor the United States District Court at Detroit, nor the Sixth Circuit Court of Appeals had any jurisdiction or power to pass on this question; indeed, by the last-named court any power to

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[2] The Cleveland Trust Company and Aluminum Company of America.

[3] In fact the defendants' Nelson patents never were put into The Cleveland Trust Company "patent pool" referred to by Justice Stone in the cited opinion.

Further, all the evidence of these contracts was finally stricken from the record by the trial judge (R. pp. 1599, 2080); and the defendant below therefore had no need to and did not develop the complete facts on the subject matter.

[4] And he acted under the mistake of fact pointed out in the last substantial paragraph of the opinion of the court below (R. 2891) and in the next paragraph hereof.

pass thereon was most carefully disclaimed (*Cleveland Trust Company v. Berry,* 99 F. (2d) 517). These tribunals passed only upon the question of priority of date of conception as between Berry and the others.

IV.

Over and over again petition and brief assert that the conclusion of the Patent Office (Law Examiner) that Berry was patentable was based upon "substantially the same record" that we have here. The fact is quite otherwise.

The Law Examiner, observing that Berry differed from the earlier Nelson disclosure of steel struts in an aluminum piston only because the Nelson struts were not "imbedded" in the central bosses, and differed from the earlier Ricardo only because Berry made Ricardo's struts of steel instead of aluminum, thought invention was involved because "it was not obvious" how this uniting of struts to bosses and skirts "could be done in a composite structure of different metals." At this time, the only existing "record" on this subject was the Law Examiner's own supposition of fact. So far as he knew, this method of "uniting" was novel—"not obvious"; but this was his fact-blunder. On the present record, it is undisputed that such uniting of different metals ("casting in") was well known in the art. All witnesses agree that the process had long been familiar; and the opinion of the court below (R. pp. 2883-4) recites that this process was old in the art. The whole basis of the Law Examiner's conclusion is therefore non-existent in the present record.

There is a further difference between the present record and that before the Law Examiner. The Hartog earlier patent (R. p. 2429) (earlier in application date) was not before him. This was regarded by the court below as of importance upon the question of patentability (Opinion, R. p. 2890).

V.

We are told (brief pp. 18, 19) that Justice Cardozo's opinion in the *Radio Case*[5] had the effect of making the Patent Office Berry-Nelson interference decision *res judicata* controlling the present controversy. Forty-eight years ago, in *Haughey v. Lee*, 151 U. S., 281-8, this court decided that the defeated party in an interference could nevertheless show, in a later infringement suit brought against him, that the patent issued to a successful opponent was invalid. This was in part in view of the public interest. (See Mr. Justice Jackson's opinion in *Muncie v. Outboard*, March 30, 1942—last main paragraph.) This rule has ever since been the settled law, expressly followed in probably all the circuits, and followed by the court below in earlier cases as well as here (*Root v. Wilett*, 84 F. (2d) 42, 43). This court certainly did not intend in the *Radio Case* to overturn that rule. The question at issue in that case was not patentability, but priority of date as between two men, one of whom was prior to the other in the making of a concededly great invention. The words used by Justice Cardozo must of course be read with reference to the question at issue.

These two issues are completely distinct, both generally and as here arising. One is, *patentability*: Did the advance step over the prior art—*viz.*, uniting the struts with the bosses and the skirt instead of with the skirt only,—constitute patentable invention?—a prior art which included Nelson's earlier patents and publication, as well as Knight, Hartog, etc. The other is, *priority*: If this step did involve invention, which of the two men was earlier?[6]

In the *Radio Case*, Armstrong sought (upon the same record) review of the issue of *priority* once awarded

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[5] *Radio Corp. v. Radio Laboratories*, 293 U. S. 1.

[6] While we do not now contest the Patent Office decision that Berry was entitled to priority over Nelson, yet even as to the specific

by the Patent Office and indeed by the Supreme Court, to De Forest. Here, we sought (upon a new record) review of the Law Examiner's erroneous idea of what was "obvious."

VI.

The petition complains because the court below erroneously said that the trial judge read into the claim "cam grinding," an element not there.[7] It is true that the court below was not verbally accurate in saying that the trial judge read "cam grinding" *into the claims,* if by "claims" we mean the literal measure of infringement, but the court did not mean that. The trial judge did read it *into the invention*[8] as the basis of finding that Berry had made a useful invention. This is a distinction without a difference.

VII.

Claim 35 was held invalid because it did not call for differential materials. The petition says that this should have been "read in." Mr. Justice Stone, in the second *Schriber-Schroth Case* (311 U. S.) did not say that the unnamed element (flexibility) should be read into the claim because it was so much emphasized in the specification. He said that "we may assume" that the patentee was right in that contention in general, but it could not be done in that case because other things in the application history were inconsistent. So here. The patent dis-

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commercially worthless form shown by both in the interference, it should be noted that the Patent Office eventually found that Nelson's conception had an earlier date than Berry's, but awarded priority to Berry on account of the technical rule of diligence in filing the application, while the Canadian Patent Office, having no such technical rule, awarded priority to Nelson.

[7] Though in the next breath it complains because the court *did not* read into claim 35 an element which was not there.

[8] He said (R. pp. 1954-55) "I don't think Berry is any good without cam grinding."

closes Berry's idea that he could have a group of claims depending on this idea of differential materials, and another group of claims depending on structure only. See, for instance, claims 6, 7, 8, 10, 14, 16, 17 and 22. These, as well as 35, are clear attempts to get away from any limitations to differential thermal expansibility.

VIII.

The petition invites comparison with the first *Schriber-Schroth Case* because the subject matter is pistons, and that is so peculiar to the Sixth Circuit. The comparison is fallacious. In that case the patent had been sustained, and plaintiff had no need to, and probably would not, sue in another circuit. In the present case Berry and his exclusive licensee, General Motors Corporation, could find infringement by sellers or users in any district in the United States, and could bring another suit in any one of the other eight circuits. In such further litigation, the General Motors Corporation, the exclusive licensee, would be the party chiefly in interest as to enforcing a monopoly by injunction, and would not be embarrassed by the usual difficulties of the poor inventor.

Many points and inferences or insinuations in the petition and brief invite refutation from the record; but they do not seem to us sufficiently material, upon the question of the allowance of the writ, to justify discussion at this time. So, too, with several reasons, not given by the court below, why its decision was right. In the interest of brevity we do not go further.

We ask that the writ be denied.

Respectfully submitted,

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PETITIONERS' REPLY TO RESPONDENTS' REPLY TO PETITION FOR CERTIORARI.

Respondents' accusation that the statement of facts in the Petition is "inaccurate" and misleading compels brief reply.

I.

This is not an ordinary patent case, but indeed an unusual patent case, as the facts show.

Calling the Berry piston "a commercially worthless device" comes with bad grace from Respondents. Respondents fought for the very claims in issue, namely, 5, 15 and 18 of the Berry patent. The Nelson patent No. 2,006,008 (R. 24, 38), application for which was involved in the interference with Berry, shows, in Figures 1, 2 and 3, a piston **exactly like Berry's**, and is there asserted to be "a preferred form of the invention" (p. 1, r. c., line 24). The ties 23 shown in the Figure 4 variation are described as simply having the function "to strengthen the connection" between the bosses and the thrust faces. Judge Tuttle called this variation "a good job of hitching" (R. 2115), while the Court of Appeals referred to that variation as "an immaterial difference" (R. 2884) and found infringement of the Berry patent if valid.

The contention that "it is conceded that there was only

a substitution of known materials with their known respective qualities," citing the Court of Appeals' recitation of what plaintiffs' expert Stellmann said, is contrary to the record. The statements quoted by the Court of Appeals are lifted from associated context (R. 81-2), and, thus isolated, create a false impression. Mr. Stellmann not only testified that the Berry structure "was something new in the piston art" in 1922, but that its construction "required more than the skill of the ordinary mechanic" (R. 2045-6). Furthermore, that it has a new mode of operation (R. 2075-6); that the Berry piston can run with a clearance of 0.0015 as distinguished from the then best all-aluminum piston, which required a clearance of 0.0050; that the Berry piston is in "another class" from the all-aluminum piston (R. 1813-4). Stellmann showed that whether the piston be ground round (R. 1804) or oval (R. 2004-6), it can be fitted closer than an all-aluminum piston. All of this testimony was based on practical experience (R. 2033), and was substantiated particularly by the fact that the then best all-aluminum piston was replaced by the Berry type piston in the Franklin air-cooled engine in 1926 (R. 106). None of this testimony was disputed by one skilled in the piston art.

Whatever the fundamental difference between Berry and the art prior, it gave the Berry piston a mode of operation and result which could not be attained by the all-aluminum piston, or by the absurd rings of the Napier, Knight and Hartog patents, or by the Nelson "single strut" piston (Fds. 12, 13, 19, R. 2089-2090, 2092).

II.

The reference to Cleveland Trust and Aluminum Company as "two strangers to the record" is amusing in view of the three-fold tie (agreements digested in the Appendix to the Petition) respecting the "so-called controlled type" (Berry) piston (R. 2665, 2747-8).

Our contention is that **because** Respondents, and those in

consort with them, so doggedly contested Berry's claims in the interference suits, not only resisting Berry, but seeking the same patent themselves, **therefore** the defendants, having had their day in court, should not be permitted to relitigate the question of validity, at least in the absence of newly-discovered non-cumulative evidence. And like any other case where a party seeks to reopen a matter, the Court should apply the maxim,

"He who seeks equity must do equity."

The pooling of patents, cross-licensing with quota restrictions, price fixation, and penalties, constitute unclean hands (Morton Salt v. Suppiger Co., ... U. S. ..., 62 S. Ct. 402; U. S. v. Masonite et al. and U. S. v. Univis et al., decided May 11, 1942).

III.

Respondents are technically correct that the patentability of the claims in issue was "sustained" only by the Law Examiner, although we showed in our Petition (p. 6) that there were three decisions sustaining patentability by the Law Examiner, and that the effort was made to have the Law Examiner reversed before every other Tribunal of the Patent Office, and even by the courts.

In a back-handed way Respondent brought in the Nelson paper (R. 2265) under the guise of relevancy on the question of priority. Thereupon Respondent sought (R. 2248) a recommendation under Patent Office Rule 126,* but were refused.

*"126. The examiner of interferences or the board of appeals may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner."

The contention that the Law Examiner "acted under the mistake of fact," pointed out "by the Court of Appeals" (R. 2891), is also contrary to the record. Of course, the Examiner not only knew about casting aluminum over steel, but specifically he had before him the Nelson paper (R. 2144), on his abortive single strut piston, which paper describes (beneath the illustrations at the bottom of the left column) "a steel strut cast integrally with the slipper portion." What the Law Examiner meant by the expression "not obvious" (R. 2231) was that the combination was not obvious to one skilled in the art, and, therefore, beyond the province of mechanical skill.

IV.

The repetition of the alleged "mistake of fact" by the Law Examiner has been discussed. There is nothing in the record now which is more pertinent on casting than what the Examiner had before him in the Nelson paper.

The Hartog patent was simply cumulative and so classed with the Napier patent (which was before the Law Examiner) by Judge Tuttle (R. 2090). Its cumulative nature and impracticability was substantiated by the testimony of the experienced and practical Stellmann (R. 1855-8), and even by Nelson's own patent, as shown in our Petition (pp. 26-7).

V.

Respondents are mistaken in what they say about Haughey v. Lee, 151 U. S. 281. Examination of the file of the patent there involved reveals that **there was no Interference.** Even if there had been, in so far as that case is in conflict with Mr. Justice Cardozo's unequivocal pronouncement in Radio Corp. v. Radio Lab., 293 U. S. 1, the older case was overruled.

That the Court below has refused, in other cases, to give full effect to the statement of this Court in the Radio Case that

"For the purpose of any controversy between Arm-

> strong and DeForest the validity of the patents must be accepted as a datum"

is more a reason why Certiorari should be granted than why it should not.

The point we make is that Respondents not only contested priority,* but sought and obtained an *inter partes* adjudication of patentability in the Interference proceedings. The adjudication being between the same parties and upon the same character of prior art, the same question cannot be relitigated here.

The situation here is no different from any other case involving *res judicata.* Where questions have once been litigated between the same parties, or their privies, they are bound (Hart Steel Co. v. Railroad Supply Co., 244 U. S. 294). Application of that doctrine here could not prejudice the right of true strangers to the Record to litigate the question of validity de novo (compare Smith v. Snow, 294 U. S. 1, with Smith v. Hall, 301 U. S. 216).

The public interest could not be derogated, but would be better served by permitting Berry to share the benefits of his invention, than by confirming in Respondents and their colleagues the continued domination of the strut piston business.

VI.

Even Respondents' counsel now state, "It is true that the court below was not verbally accurate in saying that the trial judge read 'cam grinding' into the claims," but that "the trial judge did read it into the invention." We showed in our Petition (pp. 21-22) that the trial judge did neither. He could not have done so, when he found the round-ground pistons infringed.†

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*Respondents seek, in footnote 6, to plead that the Patent Office found that Nelson's conception was earlier than Berry's. Of course, it was sought to impress the District Court with this, and much of the evidence was upon the priority phase. However, the "evidence" was so completely exploded on cross-examination that, at the argument (R. 2081), when the Court questioned the Respondents' counsel, "You are not contesting priority?" the answer was "No." In Finding 17 (R. 2091) we find Judge Tuttle doubting the alleged sketch of April 8, 1921, by: "even if in existence at that date."

†The Court of Appeals concurred.

What Judge Tuttle really meant, by his comments anent "cam grinding," was that the Berry piston could be made "real good" (R. 1946) by cam grinding (the manner in which those skilled in the art would make it), while the single strut piston could not be made good. Finally, his conclusion is shown by his Opinion that the Berry structure is "adapted for cam-grinding" (R. 2109); and by his Finding 15 (R. 2091) that the Berry structure "permits cam-grinding, as practiced in the making of pistons before Berry."

VII.

There is nothing whatever in the file history to preclude reading the low expansion capability of the strut, into claim 35. Respondents have pointed out nothing to the contrary.

VIII.

Respondents seek to distinguish the right of an inventor, from that of an adjudicated infringer, to have his case reviewed by this Court. The rights of both are based upon the Constitution. If infringement should arise outside of the Sixth Circuit, Berry is helpless. Berry resides in the Sixth Circuit (R. 1416) and any notice of infringement under R. S. 4900 (35 U. S. C. 49) would provoke a Declaratory Judgment suit with venue laid in the Circuit where the patent stands invalidated. In practical effect, therefore, anyone, anywhere, even General Motors itself, can make and sell Berry's piston without further payment of royalties, unless the judgment of the Court of Appeals is reversed.

We submit that the Writ should be granted.

Respectfully submitted,

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